

REMARKS

Applicant notes with appreciation the Examiner's allowance of Claims 4 and 27, provided that these claims are rewritten in independent form to include all limitations of the base claim from which these claims depend, plus any intervening claims. Applicant believes that the arguments below will persuade the Examiner to allow the base claims from which these claims depend. Accordingly, prior to amending the foregoing claims to place them in condition for allowance as suggested by the Examiner, Applicant will first take this opportunity to respond to the Office Action of June 3, 2005. For the reasons discussed below, Applicant requests reconsideration of the claims herein.

I. CLAIM REJECTIONS UNDER 35 U.S.C. § 103

It is well established that the Examiner bears the initial burden of demonstrating a *prima facie* case of obviousness under §103. *In re Rinehart*, 531 F.2d 1048, 189 U.S.P.Q. 143 (C.C.P.A. 1976). To this end, the *prima facie* case requires, *inter alia*, some suggestion or motivation to modify or combine the references based upon the prior art or a general knowledge in the field. *Manual of Patent Examining Procedure*, § 2143 *Basic Requirements of Prima Facie Obviousness*; *In re Rouffet*, 149 F.3d 1350, 47 U.S.P.Q.2d 1453 (Fed. Cir. 1998). "The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure." *Manual of Patent Examining Procedure*, § 2143 *Basic Requirements of Prima Facie Obviousness* (citing *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q. 2d 1438 (Fed. Cir. 1991)). Statements in the prior art, as well as the

inferences that those skilled in the art would be reasonably expected to draw therefrom, may form the basis of such suggestions. *In re Preda*, 401 F.2d 825, 826, 159 U.S.P.Q. 342, 344 (C.C.P.A.1968). However, the mere fact that an apparatus is capable of being modified to perform a claimed feature is insufficient as a basis for a non-obvious rejection without some suggestion to do so. *In re Mills*, 916 F.2d 680, 682, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). "[A]n examiner cannot establish obviousness by located references which describe various aspects of a patent applicant's invention without also providing evidence of the motivating force which would impel one skilled in the art to do what the patent applicant has done." *Ex parte Levengood*, 28 U.S.P.Q.2d 1300, 1301 (Bd. Pat. App. & Int. 1993).

The Examiner has rejected Claims 1-3, 5-26 and 28-37 under 35 U.S.C. §103 based on the disclosure of U.S. Patent 3,133,141 ("Anderson") in view of U.S. Patent 6,210,002 ("Tachibana"). In particular, the Examiner asserted that Anderson discloses the claimed invention, including a hinge connector near 18b, a hinge element 18b, a connector clamp 40 and connector means. However Anderson does not disclose (1) at least one receiving notch and protruding tab, and (2) a depression and interior ridge. Tachibana teaches the general concept of a notch 11 and tab 32b arrangement for providing a firm alignment structure. Thus, according to the Examiner, it would have been obvious to one skilled in the art at the time that the invention was made to include the design of Anderson with the modification of Tachibana for the purpose of obtaining a

firm alignment once an eyeglass structure is assembled.¹

A. Claims 1, 3, 16, 19, 22 and 26

In response to the Examiner's rejection of Claims 1 and 22,² Applicant submits that the subject of the present invention generally relates to a hinge connector assembly for rotatably connecting an earpiece to the frame of eyeglasses. As set forth in Claim 1, the assembly includes a hinge connector adapted to be located against one face of the earpiece and a hinge element attached to the hinge connector and adapted for rotative connection to a corresponding hinge element attached to a frame of the eyeglass. The invention, according to Claim 1, further includes a connector clamp adapted to be located against the earpiece, on a face opposite the face to which the hinge connector is attached. The hinge connector includes at least one receiving notch and the clamp includes one protruding tab adapted to engage said notch when the end of the earpiece is located between the connector and the clamp, and connecting means for securing the hinge connector to the connector clamp. (Claim 22 includes notches and tabs on the clamp and hinge, respectively.) The structure of Claim 1 is clearly shown in the drawings of the present application and especially in Fig. 2a thereof, which is an

¹ The Examiner has also recited some other structural features of the Anderson reference. Presumably, the Examiner's rejections of a number of the rejected claims are based on these features.

² Applicant notes that the features of Claim 22 are similar to those recited in Claim 1 except for the respective locations of the notch and tab. Accordingly, the arguments submitted with respect to Claim 1 should be applicable to Claim 22 as well (for purposes of this response). Further, should Applicant's arguments with respect to Claims 1 and 22 persuade the Examiner, many of the rejected claims should be allowed since they depend directly or indirectly on Claims 1 and 22.

exploded view of said mechanism. In the embodiment of the hinge assembly shown in Fig. 2a, the connector clamp is u-shaped.

It is respectfully submitted that Anderson in view of Tachibana, does not make the present invention, as set forth in Claim 1, obvious to one of ordinary skill in the art. In the present invention, as set forth in Claim 1, a hinge connector and a connector clamp surround the proximal end of an earpiece, with the hinge connector including at least one receiving notch and the clamp including one protruding tab, thereby to firmly engage the earpiece through the use of connecting means. (Again, as noted herein, Claim 22 provides for a similar structure where the clamp includes a receiving notch and the hinge connector includes the tab.)

In contrast, Tachibana teaches, as shown in Fig. 4 thereof, the attachment of a hinge to a glass lens of a pair of eyeglasses. Thus, Tachibana differs from being combinable with Anderson in view of the present invention in two separate aspects. Firstly, these references fail to teach or suggest, as claimed in the present invention set forth in Claim 1, how to provide a stable and secure connection between a hinge connector and connector clamp by providing a notch and tab in these respective components. Indeed, the notch of Tachibana is provided in the lens 1 itself and not in connection portion 23 provided in Tachibana.

Secondly, the combined references teach how to attach one component of a hinge to a member made of glass, and not to an earpiece of a pair of glasses, which is not constructed of glass. One of ordinary skill in the art would not transfer technology relating to how to attach one portion of a hinge to a glass member component of

eyeglasses for purposes of connecting hinge connectors and connector clamps to one another in the context of eyeglass temples. Glass in a glass lens is a material with its own special technical features, and forming a cutout or notch in a glass lens, while preserving the remainder of the lens and keeping it transparent for viewing by the eyeglass wearer, requires specialized skill in the art. One with ordinary skill in the art would not transfer this technology to a hinge connector as described in Claim 1, absent any suggestion in the art to do so.

Insofar as the Examiner appears to have rejected Claims 3, 16, 19 and 26 based on the same reasoning, Applicant submits that the rejections of these claims are overcome as well for the reasons noted above.

In addition, for purposes of clarity, the term “notches” has been replaced with “notch.”

B. Claims 2 and 23-25

Applicant submits that the Examiner has not met his burden with respect to the rejection of Claims 2 and 23-25. In particular, the Examiner has failed to cite any references showing a hinge connector comprising an “end wall” adapted to be located against a front end of the proximal end of an earpiece, as required by Claims 2 and 23, or an end wall that is attached to a hinge connector or connector clamp as required by Claims 24 and 25, respectively (which each depend from Claim 23). On page 2 of the Office Action, the Examiner asserts that “Anderson discloses the claimed invention except (1) at least one receiving notch and protruding tab and (2) a depression and interior ridge.” However, it is clear that Anderson likewise fails to disclose a hinge

connector with an end wall – as shown in Fig. 5, there is no end wall at the hinged end 38 of the bar 26 in Anderson.

C. Claims 11 and 34

Applicant herein amends Claims 11 and 34 merely to correct a typographical error in the word “pass” in these claims as originally presented.

D. Claims 13, 14, 36 and 37

Applicant further submits that Claims 13 and 36 as amended and Claims 14 and 37 are allowable over the cited prior art. In particular, the Examiner has not cited any references showing an earpiece with an indent on an external face thereof forming an indented area wherein a tongue of said clamp is adapted to engage the indent in substantially all of said indented area as required by amended Claims 13 and 36, wherein the tongue is in non-protruding alignment with the external face of the earpiece, as required by original Claims 14 and 37. Again, Anderson (whether alone or in combination with Tachibana) fails to teach or suggest an indent in the earpiece wherein a tongue of a clamp engages the indent in substantially all of said indented area and wherein the clamp is in non-protruding alignment with the earpiece. As shown in Fig. 5, clamp 40 only engages a relatively small portion of said indented area and the two prong rivet 40 of Anderson clearly is positioned on the housing 20 of the earpiece and protrudes outwardly.

E. Other Claims

Applicant notes that the Examiner has indicated that Claims 4 and 27 are allowable if rewritten in independent form to include all limitations of the base claim from which these claims depend, plus any intervening claims. Insofar as the remaining claims not specifically addressed above (i.e., 5-12, 15, 17, 18, 20, 21 and 28-35) depend either directly or indirectly from the claims discussed in Sections A, B and D herein, Applicant submits that these claims are allowable.

II. CONCLUSION

Since Anderson in view of Tachibana fails to disclose the features of independent Claims 1, 16 and 22 (as well as other claims discussed herein), all of the claims are allowable over the cited prior art. Accordingly, it is respectfully submitted that the claims of the subject application are patentably distinguishable over the prior art and the application is in condition for allowance.

Applicant also includes herewith a petition for a one-month extension of time in which to file a response to the outstanding Office Action, and accordingly, a check for the official fee of \$60.00, prescribed therefor by 37 C.F.R. §1.17 (a), in the case of a small entity, is also submitted herewith. The Commissioner is authorized to charge any additional extension fees which may be required, or to credit any overpayment, to Deposit Account No. 07-1730.

Dated: New York, New York
October 3, 2005

Respectfully submitted,

GOTTLIEB, RACKMAN & REISMAN, P.C.



Steven Stern (Reg. No. 50,320)
270 Madison Avenue, 8th Floor
New York, New York 10016
Tel. (212) 684-3900
Fax. (212) 684-3999

CERTIFICATE OF MAILING

I hereby certify that the AMENDMENT AND RESPONSE TO OFFICE ACTION DATED JUNE 3, 2005 and PETITION FOR EXTENSION OF TIME UNDER 37 C.F.R. 1.136(a) is being deposited with the United States Postal Service as first class mail in a postage prepaid envelope on this 3rd day of October 2005 addressed to:
Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

A handwritten signature in cursive script, appearing to read "Dahlia A. Bowie", written over a horizontal line.

Dahlia A. Bowie